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10/631,101

07/31/2003

Glen J. Anderson

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GATEWAY, INC.

ATTN: Patent Attorney

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N. SIOUX CITY, SD 57049

EXAMINER

TECKLU, ISAAC TUKU

ART UNIT

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2192

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/631,101	<b>Applicant(s)</b> ANDERSON, GLEN J.	
	<b>Examiner</b> ISAAC T. TECKLU	<b>Art Unit</b> 2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04/25/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-20, 21-35 and 37-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-35 and 37-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. Claims 4, 20 and 36 have been cancelled.
2. Claims 1- 3, 5-19, 21-35 and 37-48 have been examined.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1- 3, 5-19, 21-35 and 37-48 rejected under 35 U.S.C. 103(a) as being unpatentable over Sakata et al. (US 2003/0033601 A1), hereinafter Sakata in view of Cheng et al. (US 6,763,403 B2), hereinafter Cheng.

As per claim 1, Sakata discloses a method for offering alternative software, comprising:

determining an expiration date for software residing on the computer system (e.g. FIG. 2, device 67 “Expiration date checking device” and related text); and

offering the user alternative software to the fee-based software based on the expiration date of the fee-based software (paragraph [0013] “... software is offered to the user by rental or lease agreement...” and paragraph [0014] “... software is replaced with new software ...”).

Sakata does not explicitly disclose scanning a computer system of a user to detect fee-based software residing on a said computer system of the user. However Cheng discloses a method to notify users about new software update information, and new software products for which the user has expressed an interest. As illustrated by FIG. 2, analyze 204 analyzes client computer to determine list of installed fee-based software. Therefore it would have been obvious to one skilled in the art at the time of the invention was made to scan a computer system of a user to determine list of installed software as once suggested by Cheng in FIG.2 and related section.

As per claim 2, Sakata discloses the method of claim 1, further comprising the step of transmitting a message to a software vendor at predetermined time intervals prior to the expiration date (paragraph [0169] “... determining effectiveness of an expiration date transmits the current date which is obtained from the date information obtaining ...”)

Sakata does not explicitly disclose wherein the software of the user was not authored by the software vendor and is detected by a monitoring program. However Cheng discloses authenticating registered user by the service provider using conventional authentication mechanisms (col. 7:45-50 and FIG. 2, element 203). Therefore it would have been obvious to

one skilled in the art at the time of the invention was made to authenticate user to ensure that only users who are properly authorized by the service provider can obtain updates for software products as once suggested by Cheng (col. 7:45-50).

As per claim 3, Sakata discloses the method of claim 2, further comprising the step of providing the monitoring program on at least one of the computer of the user, a computer network, and a computer of the software vendor (e.g. FIG. 4 and FIG. 6 and related text).

As per claim 5, Sakata discloses the method of claim 1, further comprising, after the offering step, providing the alternative software to the user in response to receiving an affirmative response from the user (paragraph [0099] "... response to a questionnaire which the user has filled out ...").

As per claim 6, Sakata discloses the method of claim 1, further comprising, after the offering step, in response to receipt of a negative response from the user re-notifying the user of the offer for the alternative software at a specified time interval after the receipt of the negative response (in column 8, lines 20-30 "... upon a user filling out the form ...").

As per claim 7, Sakata discloses the method of claim 1, wherein the expiration date is determined by a monitoring program (paragraph [0111]).

As per claim 8, Sakata discloses the method of claim 7, wherein the monitoring program resides on the computer of the user and determines the expiration date by scanning at least one of: the files corresponding to registration of the software by the user, file types associated with software, and an installation date of software (paragraph [0111] "... start time may also be monitored ...").

As per claim 9, Sakata discloses the method of claim 1, wherein the determining step comprises querying the user on the expiration date of software and the offering step is based on a response to the query (paragraph [0099] "... response to a questionnaire which the user has filled out ...").

As per claim 10 (Currently Amended), Sakata discloses the method of claim 9, further comprising, after the offering step, in response to receipt of a negative response from the user re notifying the user of the offer for the alternative software at a specified time interval after the receipt of the negative response (in column 8, lines 20-30 "... upon a user filling out the form ...").

As per claim 11, Sakata discloses the method of claim 1, further comprising storing information detected from the software in a database, and customizing alternative software offers based on the information in the database (paragraph [0181] "... necessary software is transferred from the server to the terminal ...").

As per claim 12, Sakata discloses the method of claim 11, wherein the offering step comprises offering at least one of replacement software, complementary software, and supplementary software (paragraph [0181] "... necessary software is transferred from the server to the terminal ...").

As per claim 13, Sakata discloses the method of claim 11, further comprising detecting software characteristics selected from the group consisting of type of software, file types associated with the software, expiration date, frequency of use, and date of download or installation (e.g. FIG.8 and related text).

As per claim 14, Sakata discloses the method of claim 13, wherein the offer of alternative software is based on the detected software characteristics (e.g. FIG.8 and related text).

As per claim 15, Sakata discloses the method of claim 1, further comprising the steps of:  
installing a monitoring program on the computer system of the user (e.g. FIG. 9 and related text); and

receiving notification of the expiration date of software on the computer system (in column 8, lines 20-30 "... upon a user filling out the form ...").

As per claim 16 (Currently Amended), this is another method version of the claimed method discussed above (Claims 1 and 13), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above and below.

wherein the fee-based software is provided by a first software vendor (paragraph [0014] ‘... software is replaced with new software ... provide the updated service...’)and

The teachings of Sakata substantially disclosed the invention as claimed. However, Sakata was silent about the offer of software is made by a second software vendor different from the first software vendor. Nevertheless, Sakata discloses wherein the fee-based software is provided by a first software vendor (paragraph [0014] ‘... software is replaced with new software ... provide the updated service...’). Thus it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the suggestions of Sakata related to making an offer by a software vendor to include providing a fee-based software by a second software vendor different from the first software vendor in order to sell or market another version of the pre-installed software by a second software vendor.

It has been noted that, a claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[ (1) ] the scope and content of the prior art are to be determined; [ (2) ] differences between the prior art and the claims at issue are to be ascertained; and [ (3) ] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. *See also KSR*, 127 S.Ct. at 1734. "The combination of familiar elements according to known methods is likely to be obvious when it does no more; than yield predictable results." *KSR*, at 1739.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If



a person of ordinary skill in the art can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 1740.

"For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.*

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* t 1742.

As per claim 17, this is the system version of the claimed method discussed above (Claim 16), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 18, this is the system version of the claimed method discussed above (Claim 2), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 19, this is the system version of the claimed method discussed above (Claim 3), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 21, this is the system version of the claimed method discussed above (Claim 5), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 22, this is the system version of the claimed method discussed above (Claim 6), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 23, this is the system version of the claimed method discussed above (Claim 7), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 24, this is the system version of the claimed method discussed above (Claim 8), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 25, this is the system version of the claimed method discussed above (Claim 9), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 26, this is the system version of the claimed method discussed above (Claim 10), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 27, this is the system version of the claimed method discussed above (Claim 11), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 28, this is the system version of the claimed method discussed above (Claim 12), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 29, this is the system version of the claimed method discussed above (Claim 13), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 30, this is the system version of the claimed method discussed above (Claim 14), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 31, this is the system version of the claimed method discussed above (Claim 15), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 32, this is system version of the claimed method discussed above (Claims 16), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 33, this is the computer-readable medium version of the claimed method discussed above (Claim 1), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 34, this is the computer-readable medium version of the claimed method discussed above (Claim 2), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 35, this is the computer-readable medium version of the claimed method discussed above (Claim 3), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 37, this is the computer-readable medium version of the claimed method discussed above (Claim 5), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 38, this is the computer-readable medium version of the claimed method discussed above (Claim 6), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 39, this is the computer-readable medium version of the claimed method discussed above (Claim 7), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 40, this is the computer-readable medium version of the claimed method discussed above (Claim 8), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 41, this is the computer-readable medium version of the claimed method discussed above (Claim 9), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 42, this is the computer-readable medium version of the claimed method discussed above (Claim 10), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 43, this is the computer-readable medium version of the claimed method discussed above (Claim 11), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 44, this is the computer-readable medium version of the claimed method discussed above (Claim 12), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 45, this is the computer-readable medium version of the claimed method discussed above (Claim 13), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 46, this is the computer-readable medium version of the claimed method discussed above (Claim 14), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 47, this is the computer-readable medium version of the claimed method discussed above (Claim 15), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

As per claim 48, this is computer-readable medium version of the claimed method discussed above (Claims 16), wherein all claim limitations have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

### ***Response to Arguments***

5. Applicant's arguments filed 04/25/2008 have been fully considered but they are not persuasive.

a) The Applicant asserted that “while Sakata’s functions may be implemented by software, in the context of a pay-per-view system it is the functions themselves that expires, and not the software that implements them. Thus, the Sakata reference simply does not teach determining an expiration date for fee-based software residing on a computer system. (page 13 of 18).

The examiner disagrees with the above assertion that contrary to the above argument, it is clear that the software expires or becomes disabled when the function of the software expires. Furthermore, Sakata describes information-based consumer electronic devices tend to have software with a shorter lifetime than that of the hardware. Therefore, after a passage of time,

even if hardware is in good condition, the user cannot be provided with a new service since the software is outdated (expired) (paragraph [0012], emphasis added). Regarding to the argument that Sakata reference simply does not teach determining an expiration date for fee-based software residing on a computer system, examiner would like direct the Applicant that the Expiration date checking device 67 of Fig. 2 determines (checks) an expiration date for fee-based software (or its function) residing on a computer system (emphasis added). Thus, the above argument is not persuasive.

b) The Applicant asserted that “Offering a ‘set top box having software’ is not the same as offering ‘alternative software’ because the set top box software is not alternative to any other software, much less the fee-based software residing on a computer system as recited in the claim” (page 14 of 18).

The examiner disagrees with the above assertion. Examiner would like to indicate that the work “alternative” is broadly interpreted as “choice, another version, more possibilities, etc. Sakata clearly teaches a business mode is considered such that a set top box (STB) or the like with a short lifetime of software is offered to the user by a rental agreement or a lease agreement (paragraph [0013], emphasis added). Furthermore, Sakata describes that as a part of the monitoring of the expiration date, it is possible to secure a communication opportunity of making a call from a terminal side to a server side, so that it becomes possible that the server collects the data of the terminal by the use of this opportunity and the necessary software (alternative software) is transferred from the server to the terminal. As a result, it is possible to



offer a better service to the terminal (paragraph [0181], emphasis added). Thus, the above argument is not persuasive.

c) The Applicant asserted that “replacing is not the same as the act of ‘offering an alternative’ Additionally, 'outdated software' is not the same as 'expired software' (page 14 of 18).

The examiner disagrees with the above assertion. It is clear that by offering the software to a user, the reason is to replace the existing software and Sakata describes that as a part of the monitoring of the expiration date, it is possible to secure a communication opportunity of making a call from a terminal side to a server side, so that it becomes possible that the server collects the data of the terminal by the use of this opportunity and the necessary software (alternative software) is transferred from the server to the terminal. As a result, it is possible to offer a better service to the terminal (paragraph [0181], emphasis added) Furthermore, it is clear that when a software is expired, the function of the software is impaired or disabled, that is to say outdated. In addition, Applicant's arguments fail to comply with 37 CFR 1.111 (b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Thus, the above argument is not persuasive and the rejections will stand as set forth in the above office action.

d) The Applicant asserted that “there would be no motivation to combine the Cheng reference with the Sakata reference because there is no need in the Sakata reference to scan the set top box to detect fee-based software residing thereon” (page 15 of 18).

Examiner agreed that Sakata does not explicitly disclose scanning a computer system of a user to detect fee-based software residing on a said computer system of the user. However Cheng discloses a method to notify users about new software update information, and new software products for which the user has expressed an interest. As illustrated by FIG. 2, analyze 204 analyzes client computer to determine list of installed fee-based software. Therefore it would have been obvious to one skilled in the art at the time of the invention was made to scan a computer system of a user to determine list of installed software as once suggested by Cheng in FIG.2 and related section. By scanning the system, installed software are being detected to verify their lifetime. Thus, it is respectfully submitted that the above argument is not persuasive and the rejections will stand as set forth in the above office action.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ISAAC T. TECKLU whose telephone number is (571)272-7957. The examiner can normally be reached on M-TH 9:300A - 8:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Isaac T Tecklu/  
Examiner, Art Unit 2192

/Tuan Q. Dam/  
Supervisory Patent Examiner, Art Unit 2192